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10/635,619	08/07/2003	Hideo Nakazawa	NIT-388	9590
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EXAMINER HAMILTON, MATTHEW L				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/635,619

Applicant(s)

NAKAZAWA ET AL.

Examiner

MATTHEW L. HAMILTON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21, 23-26, 28-30, 32-35, 37 and 38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21, 23-26, 28-30, 32-35, 37 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Request for Continued Examination

1. This action is in reply to the Request for Continued Examination filed on 15 December 2008. Claims 21, 23-26, 29-30, 32-35 and 38 have been amended. Claims 22, 27, 31 and 36 have been canceled. Claims 21, 23-26, 28-30, 32-35 and 37-38 are currently pending and have been examined.

2. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Inventorship

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 21, 29, 30 and 38 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (idiomatic English). The applicant has amended the claims to overcome the rejection. The rejection is withdrawn.

6. Claims 25 and 34 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant has amended the claims to overcome the rejection. The rejection is withdrawn.

7. Claims 21, 23-26, 28-30, 32-35 and 37-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 21, 23-26, 28-30, 32-35 and 37-38 are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. The claims are not clear as to fully describe the applicant's invention.

b. Claims 21 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (idiomatic English). The first feature of the independent claim recites, *"monitoring an operation situation based on execution of said application programs with the processing device and detecting arrival of a timing for distributing information by generation of the operation situation that satisfies a predetermined criteria for the operation situation under execution of the waiting program with the processing device"* is unclear to the Examiner. For examination purposes, the Examiner interprets the claim as the mobile terminal (phone) is constantly being tracked and monitored via a global positioning system (GPS) or base station. Based on the location information, the mobile terminal

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receives periodic advertisements and information. Software/programs in the mobile device monitor the mobile terminal location and control when to receive periodic advertisements and information.

c. Claim 23 is dependent on claim 22, which is a cancelled claim. For examination purposes, the Examiner will interpret the claim is dependent on independent method claim 21.

d. Claim 25 recites the limitation "the priority" in lines 3 and 8. There is insufficient antecedent basis for this limitation in the claim.

e. Claim 29 is dependent on claim 20, which is a cancelled claim. For examination purposes, the Examiner will interpret the claim is dependent on independent method claim 21.

Claim Objections

8. Claim 30 is objected to because of the following informalities: A colon is missing after the word "programs" in the preamble. Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claim 21, 23-26, 28-30, 32-35 and 37-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Shioda et al. US Publication 2002/0044639 A1.

Claims 21 and 30:

As per claim 21, **Shioda** teaches a method and mobile terminal comprising:

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monitoring an operation situation based on execution of said application programs with the processing device and detecting arrival of a timing for distributing information by generation of the operation situation that satisfies a predetermined criteria for the operation situation under execution of the waiting program (advertising management method) with the processing device (paragraphs 0028-0031).

transmitting, to the information distribution server, a request for distributing the information based on preset contents of the distributed information under the control of the processing device in accordance with execution of said waiting program stored in the mobile terminal (paragraphs 0028-0031).

receiving the information distributed from the information distribution server in response to the request for distributing the information at the mobile terminal (paragraphs 0006, 0030 and 0031).

outputting the received information to an interface for outputting the information under the control of the processing device in accordance with execution of the waiting program (paragraph 0029).

wherein the processing device starts execution of the waiting program that is stored in the memory, and controls the waiting screen upon detecting the arrival of the timing for distributing the information in accordance with execution of the waiting program (paragraphs 0006 and 0029-0031).

wherein the processing device transmits the request for distributing the information in accordance with execution of waiting program (paragraphs 0006 and 0029-0031).

wherein the processing device outputs the distributed information to the waiting screen as the output interface for outputting the distributed information in accordance with execution of the waiting program (paragraph 0029).

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Claims 23 and 32:

As per claims 23 and 32, **Shioda** teaches the method and mobile terminal of claims 21 and 30 as described above and further teaches *wherein the processing device monitors, as the operation situation, the presence or absence of calls, the amount of traffic, and the amount of various processed data using the mobile terminal in accordance execution of the waiting program with the processing device mobile terminal* (paragraphs 0070).

Claims 24 and 33:

As per claims 24 and 33, **Shioda** teaches the method and mobile terminal of claims 21 and 30 as described above and further teaches *wherein the processing device detects the arrival of the timing for distributing the information on the basis of reception from the information distribution server in accordance with execution of the waiting program with the processing device* (paragraphs 0028-0031).

Claims 25 and 34:

As per claims 25 and 34, **Shioda** teaches the method and the mobile terminal of claims 21 and 30 as described above but does not teach *wherein an operating systems, said application programs said the waiting program, and the priority between said waiting program and said application programs are stored in the memory with the mobile terminal, and processing of the said waiting program or said application programs is executed in with the processing device accordance with the priority thereof under the operating system*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Shioda to prioritize different programs within the mobile terminal. For example, depending on the different types of cell phones and phone settings, receiving phone calls are ranked first, receiving e-mail is second, receiving text messages are third. These programs are ranked in a particular order due to settings and the desired functionality of the phone.

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Claims 26 and 35:

As per claims 26 and 35, **Shioda** teaches the method and mobile terminal of claims 21 and 30 as described above but does not teach *wherein the processing under execution of said waiting program is interrupted and said application program is started, upon detecting a request for processing said application program during execution of said waiting program with the processing device*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Shioda to wherein the program is interrupted upon detecting a request for processing of the program under the operating system of the mobile terminal. For example, when a user is surfing the Internet on their personal computer, the user is interrupted or bombarded with pop-up advertisements.

Claims 28 and 37:

As per claims 28 and 37, **Shioda** teaches the method and mobile terminal of claims 21 and 30 as described above and further teaches *wherein the request for distributing the information has a user ID for identifying a user of the mobile terminal* (paragraph 0028).

Claims 29 and 38:

As per claims 29 and 38, **Shioda** teaches the method and the mobile terminal of claims 21 and 30 as described above but does not teach *wherein the processing device receives a request for changing an output form of the output information in accordance with execution of said waiting program via an input interface of the mobile terminal, and the processing device changes an output form of the distributed information in response to the request for distributing the information in accordance with execution of said waiting program, and outputs the changed output to an output interface of the mobile terminal*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Shioda to change the output form (display) of the information in accordance with the program at the mobile terminal. For example, a web site is displayed differently when shown on a desk top computer (wide computer monitor), a laptop (a smaller computer monitor) and a cell phone display screen. These display settings

are different because of the size of the computer/cell phone screen and graphical capabilities or limitations.

Response to Arguments

11. Applicant's arguments filed 15 December 2008 have been fully considered but they are not persuasive. On page 19 of the remarks, the applicant argues, *Thus, Shioda invention has a procedure in terms of receiving the distribution information by the user's operation (manual) but has no suggestion or motive including inevitability of substitute other units (automatic reception) for the configuration.* However, the Examiner points to Shioda teaching, *"This embodiment is similar to the first embodiment shown in Fig. 7, but information representing a geographical position of the communication terminal 10a when it is used is additionally considered as another condition for advertisement information retrieval".* (pargarph 0069) and *"The communication company facility 20 may calculate or predict the change of the geographical position of the communication terminal 10a and retrieve advertisement in the moving direction of the communication terminal 10a. There may be plurality of retrieving methods, and any one of them may be employed as long as at least one piece of advertisement information can be retrieved"* (paragraph 0072). In addition, Shioda teaches, *"The advertisement information may be distributed at predetermined intervals."* (paragraph 0100). Shioda does teach distributing information by automatic reception (according to geographical location and predetermined intervals).

12. On pages 19 and 20, the applicant argues, However, the distribution information is not displayed on the waiting screen based on the waiting program installed differently from the processing program realizing the function of the telephone or the email mention in the present invention. Shioda teaches *"Referring to FIG. 13, illustrated is a routine for providing the advertisement and telephone communication function according to the seventh embodiment of the present invention. This embodiment deals with a case where the advertisement information is distributed to not only the call making terminal but also the call receiving terminal."* (paragraph 0089), *"At first, the communication terminal 10a becomes the off-hook state when the handset is off hooked. This off-hook state is detected by the communication company facility 20 (Step S801). The communication company facility 20 then sends the off-hook detection signal to the communication terminal 10a (Step S802)."* (paragraph 0090) and *"Upon receiving*

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the off-hook detection signal, the communication terminal 10a performs the advertisement information retrieval procedure according to one of the first to sixth embodiments (Step S803)." (paragraph 0091).

Shioda does teach the distribution information is distributed to the phone based upon function of the telephone. The function of the phone is interpreted broadly meaning any method of using the phone.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW L. HAMILTON whose telephone number is (571)270-1837. The examiner can normally be reached on Monday-Friday 7:30a.m-5p.m EST alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571) 272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLH
Examiner, Art Unit 3688
March 9, 2009

/James W Myhre/
Supervisory Patent Examiner, Art Unit 3688